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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,691	08/26/1999	MICHAEL P. DELANEY	DELM-2706	6911

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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 09/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/383,691

Applicant(s)

DELANEY, MICHAEL P.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-22 and 24-35 is/are rejected.
- 7) ☒ Claim(s) 12 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12 August 2003 have been fully considered but they are not persuasive. Applicant's argument that the Theimer and Rackman references do not teach or suggest the feature of if the requested access is not security blocked, determining whether the data object includes a privileged communication between an attorney and client of the attorney is not persuasive because Theimer discloses a client requesting access from a server for a specific file containing access rights. Upon verification of the client with regards to these access rights (status software, status means, determination software, determination means, determining), the server grants access to the client (Col. 10, lines 14-20) (Col. 11, lines 14-38). After access is granted to the client, the client then must verify to the server that they approve of the request (publication software, publication means, publish at node)(Col. 12, lines 10-11, Fig. 2C). Rackman discloses litigation files stored in a database that contains access control fields (access rights) to identify whether or not the file contains attorney-client information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the confidential access control fields of Rackman as part of the access rights for the files in the system of Theimer in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 13-21, 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer, U.S. Patent No. 5,649,099, in view of Rackman, U.S. Patent No. 5,903,646. Referring to claims 1, 6-9, 13, 16, 18-20, 24, 27-29, and 31, Theimer discloses a method for delegating server access rights executable access control program wherein the system comprises a server, client, a plurality of intermediaries (nodes), all connected to one another via communication network (Col. 7, lines 55-57). The server manages a resource (data object) to which the client has access rights (Col. 7, lines 59-61). The client and intermediaries are node computers comprising memory and one or more processors (Col. 8, lines 2-3). The server authenticates (security blocked) the client and each intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 14-20). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request. The server can call a function to check the permissions via an access list, check permission bits, or use other checking authorizations (Col. 11, lines 14-38). Theimer does not disclose that the resource (data object) includes attorney and client communications. Rackman discloses an access control system for litigation documents wherein the documents stored on the data base contain confidentiality fields that control access to the specified documents to the attorney's associated with the documents (privileged communication between attorney-client)(Col. 7, lines 31-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include an confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

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Referring to claims 2, 17, 30, 32, Theimer discloses the intermediary (node), after server verification of rights, approving of the request (deciding to abandon or complete request)(Col. 18, lines 14-39).

Referring to claim 3, Theimer discloses the user having rights to read and write (edit) various files (Col. 2, lines 10-18).

Referring to claims 4 and 5, Rackman discloses the users being clients, attorneys or proper counsel (attorney-affiliate)(Col. 7, lines 45-49).

Referring to claims 10 and 21, Rackman discloses the file containing attorney-client communications being displayed over a monitor (visually)(Fig. 3, 12).

Referring to claims 14, 15, 25, 26, Theimer discloses limitation imposed by the server on the user accesses (previously published)(Col. 13, 32-43).

Referring to claims 33-35, it would have been obvious for the communications within the files to be between any set of person whom would want their communications kept confidential.

4. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer, U.S. Patent No. 5,649,099, in view of Rackman, U.S. Patent No. 5,903,646 as applied to claims 1 and 16 above, and further in view of Keithley, U.S. Patent No. 5,584,025. Referring to claims 11 and 22, Theimer discloses a method for delegating server access rights executable access control program wherein the system comprises a server, client, a plurality of intermediaries (nodes), all connected to one another via communication network (Col. 7, lines 55-57). The server manages a resource (data object) to which the client has access rights (Col. 7, lines 59-61). The client and intermediaries are node computers comprising memory and one or more processors (Col. 8, lines 2-3). The server authenticates (security blocked) the client and

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each intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 14-20). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request. The server can call a function to check the permissions via an access list, check permission bits, or use other checking authorizations (Col. 11, lines 14-38). Rackman discloses an access control system for litigation documents wherein the documents stored on the data base contain confidentiality fields that control access to the specified documents to the attorney's associated with the documents (privileged communication between attorney-client)(Col. 7, lines 31-52). Theimer does not disclose the resource (data object) being audio. Keithley discloses a server that distributes multimedia including video, and audio (Col. 5, lines 26-34). It would have been obvious to one of ordinary skill in the art for the resources (data objects) of Theimer to be audio files because distribution of audio files via servers is well known in the art.

***Allowable Subject Matter***

5. Claims 12 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Benjamin E. Lanier



GILBERTO BARRON  
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